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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/015,167	12/11/2001	Jonathan A. Usuka	9080-016-999	3878
20583	7590	01/12/2006	EXAMINER	
JONES DAY			DEJONG, ERIC S	
222 EAST 41ST ST			ART UNIT	
NEW YORK, NY 10017			PAPER NUMBER	

1631

DATE MAILED: 01/12/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action
Before the Filing of an Appeal Brief**

Application No.

10/015,167

Applicant(s)

USUKA ET AL.

Examiner

Eric S. DeJong

Art Unit

1631

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 19 December 2005 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. ~~To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:~~

~~a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.~~

~~b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.~~

~~Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).~~

~~Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).~~

NOTICE OF APPEAL

2. ☒ The Notice of Appeal was filed on 20 December 2005. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☒ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
- (a) ☒ They raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☐ They raise the issue of new matter (see NOTE below);
- (c) ☒ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: see continuation sheet. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).

5. ☒ Applicant's reply has overcome the following rejection(s): see continuation sheet.

6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).

7. ☒ For purposes of appeal, the proposed amendment(s): a) ☒ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: _____.

Claim(s) objected to: _____.

Claim(s) rejected: 14, 15, 17, 20-22, 39, 40, 42, 45-47 and 58.

Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).

9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).

10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: see continuation sheet.

12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08 or PTO-1449) Paper No(s). _____

13. ☐ Other: _____.

John S. Brusca 6 January 2006

JOHN S. BRUSCA, PH.D
PRIMARY EXAMINER

EDJ

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Continuation of Item 3. NOTE:

Applicants proposed After Final amendments to the claims 14, 17, 20, 22, 39, 42, 45, 46, 47, and 58 introduce substantive changes that raise new issues requiring further search and/or consideration, and therefore will not be entered. The proposed amendments would alter the scope of the claimed steps for "determining a correlation value", "repeating said determining and establishing steps", and for "identifying one or more genotypic data structures", and therefore require further search and/or consideration.

Continuation of Item 5. NOTE:

The rejection of claims 14, 17, 20-22, 39, 40, 42, 45-47, and 58 under 35 U.S.C. § 101 as being directed to non-statutory subject matter is withdrawn in view of arguments presented by applicants.

Continuation of Item 11. NOTE:

The remaining objections and rejections in the previous Office Action mailed 20 July 2005 are maintained for reasons of record.

The disclosure is objected to because it contains embedded hyperlink and/or other forms of browser-executable code. This objection is maintained and reiterated from the previous Office action.

The proposed amendment to the specification does not resolve the above described issue. Specifically, the proposed amendment only deleted the text "http://" from the hyperlinks present in the specification, however any web address that begins with "www" will also remain as an active hyperlink. Therefore applicants amendment would not resolve the above described issue of active hyperlinks remaining in the specification.

Claims 14, 15, 17, 20-22, 39, 40, 42, 45-47, and 58 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicants regards as the invention. This rejection is maintained and reiterated from the previous Office action.

If the proposed After Final amendments were entered, the amendments would be sufficient to overcome the instant rejection as it would resolve the issue of proper antecedent basis for the phrase "the correlation value associated with the respective genotypic data structure" in the instant claims.

Claims 14, 15, 17, 20-22, 39, 40, 42, 45-47, and 58 are rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement.

If the proposed After Final amendments were entered, the amendments would be sufficient to overcome the instant rejection in part as it would resolve the issue of NEW MATTER introduced from the limitation of "the one or more genotypic data structures has the property that the correlation value associated with the respective genotypic data structure."

Applicants arguments that the limitation of a "plurality of genotype data structures that are not in said one or more genotypic data structure", as recited for example in line 19 of proposed claim 14, has been fully considered but is not found persuasive. Applicants argue that a plurality of genotypic data structures are established in the instant specification and in the claims, which may be further divided into the following classes: (i) the identified one or more genotypic data structures in that have a high correlation value and (ii) those genotypic data structures in the plurality of data structures that are not in the identified one or more genotypic data structures (i.e., that do not have high correlation values). Applicants further cite Figure 2, page 5, lines 1-10, and page 28, lines 8, 9, and 12-14 in support of the argument.

Applicants argument has been fully considered but is not found persuasive. Applicants argue that the class (ii) of genotypic data structures are the plurality of data structures that are not in the identified one or more genotypic data structures, and further asserts that this is equivalent to the genotypic data structures that do not have a high correlation value. This assertion is not agreed to as the scope of the two characterizations are not equivalent. The limitation of "data structures that are not in the identified one or more genotypic data structures" encompasses embodiments wherein genotypic data structures which are not established or determined by the claimed method steps are included in the identifying step. As such the scope of this limitation extends well beyond the established data structures that do not have a high correlation value. Therefore applicants argument is not found persuasive.

For the benefit of Applicants, an amendment to the instant claims reciting "genotypic data structures that do not have high correlation values" in place of the current limitation of "genotypic data structures that are not in said one or more genotypic data structures" would be sufficient to overcome this aspect of the NEW MATTER rejection.